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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/120,664 07/22/98 GAVIN

D. 101792-100

EXAMINER

HM12/0426

DALE LYNN CARLSON
WIGGIN & DANA
ONE CENTURY TOWER
NEW HAVEN CT 06508-1832

CELSEA, D
ART UNIT

PAPER NUMBER

3

1654
DATE MAILED:

04/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/120,664

Applicant(s)
Gavin et al.

Examiner
Bennett Celsa

Group Art Unit
1654



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-39 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-39 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- *Certified copies not received: _____.
- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-39 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 and 35-38, drawn to a composition (e.g. biocidal) comprising composite particles of a metal containing core and a pyrithione adduct shell, classified in class 424 , subclass 405.
 - II. Claims 12-24 and 32-34, drawn to a method of making a composite particle copper pyrithione, classified in class 514 , subclass 345+.
 - III. Claims 25-31, drawn to a coating composition and method of using to reduce/inhibit organisms, classified in class 156, subclass 300+.
 - IV. Claim 39 , drawn to a shampoo or skin care composition comprising composite particles of a metal core and a pyrithione shell, classified in class 510, subclass 119..
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product (e.g. biocidal composition) as claimed can be made by another and materially different

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process such as those described in US. Pat. No. 5,510,109 and U.S. Pat. No. 5,595,750 on page 1 of the specification.

3. The compositions of Groups I, III and IV are drawn to distinctly different uses, would require different ingredients and are drawn to totally different areas of search as to constitute independent and/or distinct inventive compositions.

4. The method of Group II is independent and/or distinct from Groups III and IV which are drawn to different compositions having different uses and ingredients as compared to the method of making the composite. Additionally, Groups II-IV are drawn to divergent art areas requiring separate and individually burdensome searches.

5. Because these inventions are distinct for the reasons given above and

- a. have acquired a separate status in the art as shown by their different classification
- b. require different and separately burdensome manual and computer searches;
- c. due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES.

Upon selection of the Group I invention, the following election of species is herein required:

This application contains claims directed to the following patentably distinct species of the claimed invention: composition comprising different metals and pyrithione adduct compounds

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which respectively differ structurally, physicochemically, functionally and/or by means of manufacture as to constitute independent and/or patentably distinct species..

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species (e.g. a single metal and a single pyrrithione derivative compound) that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. *A structure of the elected pyrrithione derivative, if not present, in the specification, is hereby requested for purposes of facilitating searching.* An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (703)308-0254.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa

Bennett Celsa
April 22, 1999

